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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/635,910

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John Butler

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22852

7590

09/30/2010

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EXAMINER

YANG, ANDREW

ART UNIT

PAPER NUMBER

3775

MAIL DATE

DELIVERY MODE

09/30/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/635,910	Applicant(s) BUTLER ET AL.	
	Examiner ANDREW YANG	Art Unit 3775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 104-112 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 104-112 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/14/2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 14, 2010 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 106, 108, and 112 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 106 and 112 claim that a sum of the diameters of at least two of the accessways is greater than the radius of the sealing member. As discussed during the interview the disclosure does not state or imply what is claimed in claims 106 and 112. The Attorney argued that Figure 33 does

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show the claimed subject matter; however, nowhere in the disclosure does it state the figures are to scale. Claim 108 claims that the axes of the two accessways intersect proximate an axis of the sealing member. The specification does not disclose the claimed subject matter; a further review of the figures also fails to clearly show the claimed subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 104, 105, 107, and 108 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fadem et al. (U.S. Patent No. 6254533) in view of Beane et al. (U.S. Patent No. 5906577).

Fadem et al. discloses a surgical device 10 having a longitudinal axis a distal ring 14, a proximal ring 18, and a wound retracting sleeve. The sleeve extends between the rings from an insertion configuration to a retraction configuration so that the overall amount of sleeve extending between the rings is less in the retracting position (Column 4, Lines 50-52). The opening of the sleeve approaches a diameter of the rings as the distance between the rings is shortened since the sleeve is shortened until the sides are in a tight contiguous engagement with the sides of the wound (Column 4, Lines 50-52), meaning the sleeve is moved from a loose configuration where the opening is not as

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wide to the tight configuration where the sleeve retracts the wound opening and thus the opening of the sleeve becomes larger. A sealing member 108 is releasably coupled to the proximal ring 18 has an access way 114 that has a seal and is dome shaped.

Fadem et al. fails to disclose at least three accessways on the sealing member with at least two of the accessways converging to a point located below a circumferential extent of the sealing member. Beane et al. teaches a wound retracting sleeve as seen in Figure 7A that has a sealing member 114 that provides a gas tight seal. As seen in Figure 7B sealing member has two access ports 118 and 120. The sealing member can also be provided with plurality of access openings to simultaneously accommodate a plurality of hands and/or instruments to be inserted into the body cavity (Column 13, Lines 50-53). Therefore, it can be construed from Beane et al. that there can be at least three accessways in a sealing member since accommodating a plurality of hands and an instrument simultaneously suggest three accessways. It would have been obvious to one skilled in the art at the time the invention was made to construct the dome shaped sealing member of Fadem et al. with at least three accessways in view of Beane et al. in order to accommodate a plurality of hands and instruments simultaneously.

Regarding the limitation in claim 104 that the axes of at least two of the accessways converge at a point located below the circumferential extent of the sealing member, it is noted that placement of three accessways on a domed surface has the inherent characteristic that at least two accessways will have there axes converge at a point. The location of the point is a function of where the center of each accessway is

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arranged on the dome. The Applicant has not disclosed any particular benefit of such a configuration, therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Fadem et al. as modified by Beane et al. with the accessways arranged so that the axes of at least two accessways converge at a point below the circumferential extent of the sealing member since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Regarding claims 105 and 108, the limitation is made obvious due to the same reasoning as stated above. The location of the axes of is function of how the accessways are arranged, and rearranging parts of a device involves only routine skill in the art.

Regarding claim 107, the limitation is made obvious due to similar reasoning as stated above. Furthermore, Beane et al. teaches that the plurality of accessways is to accommodate a plurality of hands, it would be obvious to place two accessways on opposing sides of the sealing member as this would provide the most ergonomic configuration to provide comfort for the surgeon during use.

Claims 109-111 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fadem et al. (U.S. Patent No. 6254533) in view of Cuschieri et al. (U.S. Patent No. 5480410).

Fadem et al. discloses the invention as substantially claimed as is discussed above. Fadem et al. fails to disclose at least three accessways in the sealing member. Cuschieri et al. teaches a sealing member 2 having three accessways (Figure 1) to

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allow access of a plurality of laparoscopic instruments (Column 3, Lines 24-27). It would have been obvious to one skilled in the art at the time the invention was made to construct the device of Fadem et al. with at least three accessways in view of Cuschieri et al. to allow access of laparoscopic instruments into the abdominal cavity.

Fadem et al. fails to disclose that a proximal end of at least one of the accessways terminates at a proximal surface of the dome shape. Cuschieri et al. teaches the proximal end of the seals terminate at the proximal surface of the sealing member (Figures 1 and 5). The seals are iris seals that provide a relatively simple way to form a gas tight seal that may be maintained at all times such that the iris seal sealedly receives a tool or hand (Column 4, Lines 34-37). It would have been obvious to one skilled in the art at the time the invention was made to construct the device of Fadem et al. with an iris seal such that a proximal end of the accessway terminates at a proximal surface of the dome shape in view of Cuschieri et al. in order to provide a simple way of forming a gas tight seal that can be maintained even during insertion and removal of surgical tools.

Regarding claims 110 and 111, the point at which the axes converge of at least two accessways on a dome shape is a function of where the accessways are arranged. As stated above, since the Applicant has not provided any reasoning, benefit, or that such a configuration solves any problems, the limitations of claims 110 and 111 are obvious to one skilled in the art since rearranging or parts in a device requires only routine skill in the art. In re Japikse, 86 USPQ 70.

Response to Arguments

Applicant's arguments with respect to claim 104 and 109 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDREW YANG whose telephone number is (571)272-3472. The examiner can normally be reached on IFP.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Barrett can be reached on (571)272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrew Yang/
Examiner, Art Unit 3775

/Thomas C. Barrett/
Supervisory Patent Examiner, Art
Unit 3775

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